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Nicholas J. Seay
Quarles & Brady LLP
1 South Pinckney Street
P.O. Box 2113
Madison, WI 53701-2113

EXAMINER
MORGAN, ROBERT W

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/052,659
Filing Date: January 18, 2002
Appellant(s): DVORAK ET AL.

Michael A. Jaskolski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/1/09 appealing from the Office action mailed

4/24/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2005/0102374   MORAGNE et al.   5-2005

2002/0010679   FELSHER   1-2002

5,544,255   SMITHIES et al.   8-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-8 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Morange et al., (U.S. Pub. 2005/0102374) in view of Felsher, (U.S. Pub. 2002/0010679), and

Smithies et al. (U.S. Patent No. 5,544,255).

3.   As per claim 1, Morange et al. discloses a system for distributed computing in which

multiple different applications are in use connected on a common computer network, (Morange

et al., Abstract; Fig. 19A-C; ¶ 50, 255-326) (disclosing a comprehensive Universal Software

Platform).

Felsher fails to explicitly disclose such a platform, however, it is likely that such a

distributed computing platform is inherent in the system disclosed by Felsher due to the

disclosure of multiple different applications within the system, (Felsher ¶ 10, 91, 94, 120-188,

249). Felsher further discloses comprising a clinical exchange server on the network, the clinical

exchange server including memory, (Felsher Fig. 1, and 2), the clinical exchange server

programmed:

(i) to maintain a reference table, the reference table including a list of applications on the

network and information about the patient identification number used by each application,

(Felsher, ¶ 266-268,279).

(ii) to maintain a list of events reported to it by other applications on the network, (Felsher, ¶

266-268,279) and

(iii) to respond to inquiries from a first application about an event recorded by a second

application by transmitting a query to the second application based on the information in the

reference table and the list of reported events, (Felsher ¶ 264).

It would be obvious to one of ordinary skill in the art at the time of the invention to

combine Morange et al. and Felsher. The motivation would have been to provide an

infrastructure for efficient transmission, use and security protection of electronic medical

records, (see: Felsher, Abstract, ¶ 14).

In addition, neither reference explicitly teaches different identification numbers. Smithies

et al., however, does teach wherein the application distinct identification numbers include a first

identification number used by a first application and a second identification number used by a

second application where the second identification number is different than the first

identification number (see: column 18, lines 5-56 of Smithies et al.).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to incorporate this feature into the systems of Morange et al. and Felsher. One of ordinary skill in

the art would have been motivated to combine these features in order to determine an identity

(see: column 17, lines 22-25 of Smithies et al.).

4.   As per claim 2, Morange et al., Felsher, and Smithies et al. teach the system of claim 1 as

described above. Felsher further discloses a system wherein the clinical exchange server also

maintains an abstract about the events sent to it to facilitate exchange of information between the

applications, (Felsher, ¶ 266-268,279) (transactions are events, and an index of transaction

records is considered to be an abstract of such events).

5.   As per claim 3, Morange et al., Felsher, and Smithies et al. teach the system of claim 1 as

described above. Felsher further discloses a system wherein the reference table includes a master

patient index identification code assigned to the patient as well as the application specific

identification code assigned to the patient by each application, (Felsher, ¶ 266-268,274, 279)

(disclosing both indexed codes and an application-specific rolling code changed after each

access).

6.   As per claim 4, Morange et al., Felsher, and Smithies et al. teach the system of claim 1 as

described above. Felsher further discloses a system wherein the clinical exchange server also

stores health insurance information about each patient so that such health insurance information

can easily be accessed by any of the applications, (Felsher, ¶ 318) (the system is HIPAA

compatible, thus it is obvious that the system handles health insurance information, such as claim

information).

7.   As per claim 5, Felsher discloses a computer network for operation by a healthcare

delivery enterprise, the network including a plurality of servers, the network comprising a

clinical exchange server including a storage device, (Felsher, Fig. 1, ¶ 328) (disclosing (6) an

entrusted medical information database), the clinical exchange server programmed to store in the

storage device a reference table, the reference including a master patient identifier for each

patient, and any separate identifying code used for the patient by any of the application

programs, so that the identifying code used by an application for a patient can be found by accessing the reference table, (Felsher, ¶ 266-268,279, 334-339) (the patient medical information trust index is a form of reference table that stores a patient I.D used by the encryption application and other recipient applications and applets).

the clinical exchange server further programmed to facilitate information exchange between the applications by using the reference table to extract information from an application requested by another application, (Felsher, ¶ 132, 164-167, 266-272, 279, 334-339) (disclosing query applications that can be used with the reference table).

Felsher fails to expressly disclose operating a plurality of application programs and a list of application programs. However, it is likely that such a plurality of application programs and a list of application programs is inherent in the system disclosed by Felsher due to the disclosure of multiple different applications within the system, (Felsher ¶ 10, 91, 94, 120-188,249). Furthermore, Morange et al. discloses a system operating a plurality of application programs and a list of application programs, (Morange et al., Abstract; Fig. 19A-C; ¶ 50, 255- 326) (disclosing a comprehensive Universal Software Platform).

In addition, neither reference explicitly teaches different identification numbers. Smithies et al., however, does teach wherein the application distinct identification numbers include a first identification number used by a first application and a second identification number used by a second application where the second identification number is different than the first identification number (see Column 18, lines 5-56 of Smithies et al.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the systems of Morange et al. and Felsher. One of ordinary skill in

the art would have been motivated to combine these features in order to determine an identity

(see column 17, lines 22-25 of Smithies et al.).

8.   As per claim 6, Morange et al., Felsher, and Smithies et al. teach the computer network of

claim 5 as described above. Felsher further discloses a computer network wherein the clinical

exchange server also maintains a table of events associated with patients, the table of events

including identifying information about the events and the identification of the application

holding information about the event, (Felsher, 266-272) (transaction records are considered to be

a table of events).

        The statement of obviousness and motivation to combine is as disclosed in the rejection

of claim 1 and incorporated herein by reference.

9.   As per claim 7, Morange et al., Felsher, and Smithies et al. teach the computer network of

claim 6 as described above. Felsher further discloses a computer network wherein the event table

also includes an abstract about each of the events, (Felsher, 266-272) (A descriptive header is

considered to be a form of abstract).

        The statement of obviousness and motivation to combine is as disclosed in the rejection

of claim 1 and incorporated herein by reference.

10.   Claims 8 and 19-20 contain the same or substantially similar limitations as claims 4, 1,

and 1 (respectively) and therefore the reasons for the rejection of claims 4, 1, and 1 are

incorporated herein by reference.

11.   Method claims 14-18 substantially repeat the subject matter of claims 1-4 as a series of

steps rather than as a set of "means-plus-function" elements. As the underlying system has been

shown to be fully disclosed by the teachings of Morange et al., Felsher, and Smithies et al. in the

above rejection of claims 1-8, it is readily apparent that the Morange et al., Felsher, and Smithies

et al. references include a method. As such, these limitations are rejected for the same reasons

provided in the rejection of claims 1-8 and incorporated herein.

(10) Response to Argument

In the Appeal Brief filed 1 September 2009, Appellant makes the following arguments:

(A) Neither Morange nor Felsher teach or suggest applications that use different identifier

for the same patient.

(B) Felsher clearly does not teach or suggest that second query is generated for a second

application in response to reception of a first query at an exchange server.

(C) Smithies fails to teach or suggest both a list of applications and associated patient

identifiers.

(D) Morange, Felsher, nor Smithies fail to teach or suggest responding to an inquiry from

a first application by transmitting a query to a second application based on information in the

reference table.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Response to Arguments (A) and (C):

In response to the first and third argument, the Examiner respectfully submits that the

Smithies reference teaches a person registered with the client application (2. Fig. 8) using a

unique ID for application called AID and additionally, an application (2, Fig. 8) can register a

person with itself using application's unique person-identifier (AUID) (see: column 18, lines 5-

56). Furthermore, Smithies teaches that the AUID is cross-links with any new records or

previous registrations for a person by other applications as well as scanning to applications for

all persons registered with other applications (see: column 18, lines 52-63). This clearly indicates

that there are two different patient identifiers (AID and AUID) for the current application (2, Fig.

8) (second application) and a scan to check for previously registered applications (first

application) using these patient identifiers (AID and AUID) suggesting a first identification

number used by a first application and a second identification number used by a second

application where the second identification number is different than the first identification

number.

       <u>Response to Arguments (B) and (D):</u>

       In response to the two and fourth argument, the Examiner respectfully submits that

Morange is relied on for teaching a universal software platform (199, Fig. 19-20) including

communications and transactions on a RAN global network (108, Fig. 19-20) and any other

network(s) (see: paragraph 255-326). Felsher is relied on for teaching that a recipient may make

a query to search the medical record (see: paragraph 264). In addition, Felsher teaches that the

patient medical information trust index is a form of reference table that stores a patient I.D. used

by the encryption application and other recipient applications and applets (see: paragraphs 266-

268, 279, 334-339). Smithies' is relied on for teaching a person registered with the client

application (2. Fig. 8) using a unique ID for application called AID and additionally, an

application (2, Fig. 8) can register a person with itself using application's unique person-

identifier (AUID) (see: column 18, lines 5-56). Thus, the combination of Morange, Felsher and

Smithies teach the limitations of Applicant's claimed invention.

       Furthermore, the claim language only recites that a first query be performed to address

whether there is either a first application or a second application using different patient

identifiers. Moreover, it is noted that the features upon which Applicant relies (i.e., "...**second query** is generated for a second application") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, <u>when taken in combination with the knowledge of average skill in the art</u>, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

    (i)   obviousness does not require absolute predictability;
    (ii)   non-preferred embodiments of prior art must also be considered; and
    (iii)   <u>the question is not express teaching of references, but what they would suggest</u>.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

As such, it is respectfully submitted that Applicant appears to view the applied reference

in a vacuum <u>without considering the knowledge of average skill in the art</u>.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert Morgan/
Primary Examiner, Art Unit 3626

Conferees:

/CLG/
Luke Gilligan
Supervisory Patent Examiner
Tech Center 3600

Vincent A. Millin   /VM/
Appeals Practice Specialist
Technology Center 3600